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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/716,656

11/19/2003

David R. Cheriton

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EXAMINER

POLTORAK, PIOTR

ART UNIT

PAPER NUMBER

2434

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/716,656	<b>Applicant(s)</b> CHERITON, DAVID R.	
	<b>Examiner</b> PETER POLTORAK	<b>Art Unit</b> 2434	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-11,14-20,22,24-31 and 34-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-11,14-20,22,24-31 and 34-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/3/8 has been entered.

### ***Response to Arguments/Amendments***

2. Applicants arguments have been carefully considered.
3. *Applicant contests 35 USC § 101 rejections. In particular, applicant argues that claim 6, for example, "is directed, in pertinent part, to a router, and claim 7, in pertinent part, to a lookup unit, both of which are hardware devices." In another example, applicant argues that as per claims 30-31 and 34-41 the claim language recites "computer readable media" and thus, the claim language is statutory.*

The examiner acknowledges applicant's diligence in expediting the prosecution by amending the claims (e.g. adding the term "interface") to conform to 35 USC § 101 requirement. However, it appears that the examiner did not present the point clearly enough to address issues pertaining the statutory requirement.

The specification raise two main concerns that the examiner attempted to articulate, as pertaining to the claim language.

Paragraph 69 and 72 (see US PUB 2005/0129019, which is a U.S. Publication of applicant's invention) clearly specify that applicant's invention may be accomplished

with use of software. Software is non-statutory (unless implemented on a computer readable medium, such as disk) and, as a result, the claim language (in light of the specification) that does not explicitly recite the use of hardware, permits the situation wherein the claim limitation is directed simply to software. Also, note “interface” (e.g. network interface, application program interface (API), etc.) does not necessary have to be implemented in hardware. In fact, program modules enabling a computer to communicate with a network have an interface (network interface) that facilitate applications to communicate (send/receive data and commands) with these program modules. In other words, “a network interface” does not limits the term to a hardware device and, as a result, this term would not address the 35 USC § 101 concerns. Similarly, a lookup table is simply a data structure and a router, although often referred to a hardware device, similarly to a proxy, firewall, etc. could be implemented in software. In order to address the 35 USC § 101 rejection, the examiner suggests including in the claim language a term such as “a processor” or “memory”.

Additionally, it is noted that although software embedded on computer readable medium is statutory, the specification defining the computer readable medium as carrier wave, for example, does not meet the requirement of patentability. In paragraph 75 (once again, the examiner refers to US PUB 2005/0129019), the specification define a computer readable media as “magnetic storage media... and data transmission media”, which is defined as “computer network, point-to point communication, and carrier wave transmission media”. The examiner suggests to

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exclude "data transmission media" as a part of "computer readable medium (as amending the specification, the examiner also suggest to pay attention to use of periods, in particular in paragraph 75, which should be, perhaps, replaced by commas, e.g. " integrated circuits\_volatile storage media").

4. Applicant's arguments towards 35 USC § 102, 103 and 112 rejections, especially in light of the newly introduced amendments, are found persuasive and, as a result, the 35 USC § 102 and 103 rejections are withdrawn.

5. Claims 1, 4, 6-11, 14-20, 22, 24-31 and 34-49 have been examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 4, 6-7, 30-31, 34-41, 43-49 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See the remarks in the Response to Arguments.

Appropriate correction is required.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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- Cheng (USPN 6823462),
- Jiang (USPUB 2002/0032773),
- Cheriton (David R. Cheriton and Willy Zwaenepoel, "Distributed Process Groups in the V Kernel, ACM Transactions on Computer systems, Vol. 3, No. 2, May 1985, pg. 77-107).

**The newly presented claims overcame the prior art but they remain rejected based on previously stated 35 USC § 101 rejection.**

/Peter Poltorak/

Examiner, Art Unit 2434

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434